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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,535	01/22/2002	Keith G. Copeland	97,008-X	7198

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EXAMINER

WARDEN, JILL ALICE

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/054,535	Applicant(s) COPELAND ET AL.	
	Examiner Jill A. Warden	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 72-98 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 92-98 is/are allowed.
- 6) ☒ Claim(s) 72-74 and 79-87 is/are rejected.
- 7) ☒ Claim(s) 75-77 and 88-91 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d)-or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 72-74 and 79-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minekane in view of Azuma, et al.

Minekane teaches an automatic chemical analysis apparatus including a plurality of separate reagents which are used in a plurality of different analysis reactions. The apparatus employs a reaction carousel which includes an annular array of reaction cuvettes on the outer circumference and a plurality of reagent bottles inside the annular array. The apparatus includes a master control unit which includes information concerning each sample and different chemical tests to be performed on each sample as well as information on the content and location of the reagent bottles, which information has been input from "suitable data input means." Column 2, lines 19-34. Minekane specifically teaches that information on position and content of the reagent bottles is provided on bar codes affixed to the reagent bottles. Column 3, lines 60-65. Conventional reagent dispensers transfer reagent from the reagent bottles to the reaction cuvettes, and a sample dispenser can be employed to dispense sample into the reaction cuvettes.

Minekane does not teach employing slides instead of cuvettes, and employing barcodes on the slides.

The use of sample slides instead of reaction cuvettes is well known in the art. See, for example Azuma, et al. who teach employing chemical analysis elements (11) (i.e. sample slides) in an automated chemical analyzer. Azuma, et al. also teach that the elements include a barcode (11a) which includes information on the type of test being performed on the slide. Column 3, lines 7-35. Azuma, et al. further teach that it is more conventional to use slides when employing dry chemical reagents. However, it is

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clearly appropriate to employ slides instead of cuvettes in order to lessen the amount of sample and reagents employed in the test.

It would have been obvious to one having ordinary skill in the art, to modify the apparatus of Minekane to employ slides with bar codes in place of the reaction cuvettes in order to minimize sample size, as well as employ dry chemistries. Such use of dry chemistries would not eliminate the use of reagent bottles, as other liquids, such as sample and wash liquids would still need to be provided to the slides. With respect to the barcodes, these would be considered "suitable data input means" as discussed in Minekane.

Terminal Disclaimer

The terminal disclaimer filed on February 2, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. patent no. 6,352,861 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Allowable Subject Matter

Claims 92-98 are allowed.

Claims 75-78 and 88-91 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach, nor fairly suggest, reading identifying information from a bar code on the slide to determine whether or not reagent should be dispensed

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onto the slide, relative movement between the slide support and reagent containers or mechanical actuation of the reagent containers within a method of dispensing reagents onto a slide substantially as claimed in the instant claims.

Response to Arguments

Applicant's arguments filed February 2, 2004 have been fully considered but they are not persuasive. Applicant argues there is no teaching to combine the references and that one of ordinary skill would not have been motivated to look to the secondary reference, as it is a very different method. Examiner disagrees. Both references are directed to automatic chemical analyzers, which are indeed, the same field of endeavor. As to suggestion for combining references, the examiner has supplied such. No such suggestion need come directly from the references. One of ordinary skill in the art has some knowledge of problems and solutions and would be so motivated to look to similar art to find solutions for problems in dispensing in chemical analyzers.

Applicant further argues that the combined teachings do not provide for dispensing on a slide, as Azuma teaches a measuring element, not a slide. Examiner takes the position that the measuring element of Azuma is a slide, as slide is understood to one of ordinary skill in the analytical chemistry art.

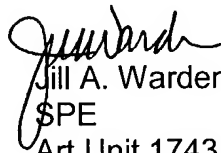
Applicant argues that neither reference determines if a reagent should be dispensed by using identifying information from the slide. Again, examiner disagrees. Position of the slide or cuvette is information from the slide or cuvette used to dispense reagents and sample. Both Minekane and Azuma teach reading positional information from the slide or cuvette.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Jill A. Warden at telephone number (571) 272-1267.


Jill A. Warden
SPE
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